

AMENDMENTS TO THE DRAWINGS

Eleven amended drawing figures are attached following page 24 of this paper. The amended drawing figures are numbered 2A and 3-11. The Applicant submits that the attached replacement sheets represent formal drawings and no new matter has been introduced by the replacement sheets.

REMARKS / ARGUMENTS

The present application includes pending claims 1-28, all of which have been rejected. By this Amendment, claims 1, 5-12, 14-18, and 22-27 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-10 and 18-28 stand rejected under 35 U.S.C. § 112, 2nd ¶, for allegedly failing to set forth the subject matter which the Applicant regards as the invention. Claims 11-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mikkonen (USPN 6,822,971), in view of Ansell (USPN 6,367,019). Claims 1-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson (Fredrik Andersson and Magnus Karlsson, "Secure Jini Services in Ad Hoc Networks," 2000). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. REJECTIONS UNDER 35 U.S.C. § 112

Claims 1-10 and 18-28 stand rejected under 35 U.S.C. § 112, 2nd ¶, for allegedly failing to set forth the subject matter which the Applicant regards as the invention. The Applicant has amended claims 1, 5-10, 18, and 22-27, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant submits that the claims are

no longer ambiguous and the rejection under 35 U.S.C. § 112 should be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir.

1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II. The Proposed Combination of Mikkonen and Ansell Does Not Render Claims 11-17 Unpatentable

The Applicant now turns to the rejection of claims 11-17 as being unpatentable over Mikkonen in view of Ansell.

A. Independent Claim 11

With regard to the rejection of independent claim 11 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Mikkonen and Ansell does not disclose or suggest at least the limitation of “detecting when the media peripheral is communicatively coupled to the node,” as recited by the Applicant in independent claim 11.

The Office Action states the following:

Mikkonen (USPN 6822971) discloses a method for establishing secure access (a tunnel col. 8 lines 1-12) to a media peripheral (PCMCIA card, e.g. object 62 (with a storage element 56» via a node (e.g. agent 34 or 130) in a communication network (e.g. a network including a correspondent node/entity 22 Fig. 1, 154 Fig. 3, 154 Fig. 4 etc.), the method comprising: detecting when the media peripheral is communicatively coupled to the node (col. 7 lines 40-

44); acquiring data associated with the media peripheral, registering media peripheral (for subsequent operation) and utilizing the acquired data to facilitate secure communication between the media peripheral and the communication network (col. 7 line 44-col. 8 line 12). Mikkonen discloses reading the data from the media peripheral (col. 6 lines 28-43 col. 7 lines 1-17 and col. 7). The examiner considers the node to be a media exchange server and points to Fig. 2 that discloses the data comprising at least one user identifier.

See the Office Action at pages 3-4. The Applicant respectfully disagrees. The Examiner has equated the "media peripheral" and "node" terms that are used in Applicant's claim 11 to the "storage element 62" and the "agent 34," respectively, as used by Mikkonen.

Initially, the Applicant points out that **the storage element 62 of Mikkonen is not a media peripheral, which communicates securely with a communication network**, as recited in Applicant's claim 11. The storage element 62 is disclosed as non-volatile memory that stores an "identifier address", such as an IP address. See Mikkonen, col. 6, lines 28-33. The storage element 62 is engaged with a terminal to provide an IP address, or other identifier address by which to identify the terminal from which a packet of data is transmitted. There is no disclosure or suggestion that the storage element 62 of Mikkonen securely communicates with the communication network.

With regard to Applicant's "detecting" limitation, the Examiner relies for support on the following citation from Mikkonen:

First, and as indicated by the segment 132, the address of the foreign agent 130 is determined by the data terminal 126, and the

data terminal 126 is registered at the foreign agent. Such procedure is here referred to as agent solicitation/agent advertisement.

See Mikkonen, col. 7, lines 40-44. As already stated above, the Examiner has already equated the “media peripheral” and “node” terms that are used in Applicant’s claim 11 to the “storage element 62” and the “agent 34” of Mikkonen, respectively. The Applicant is confused as to why the Examiner is relying on col. 7, lines 40-44 of Mikkonen since this citation relates only to the data terminal 126 and the foreign agent 130, as shown in Figure 3 of Mikkonen, and it does not relate to the storage element 62 (equated by the Examiner to the “media peripheral”) and the agent 34 (equated by the Examiner to the “node”). Even assuming for the sake of argument that the data terminal 126 equates to a “media peripheral” and the foreign agent 130 equates to a “node,” the Examiner’s argument is still deficient. Namely, the above citation from Mikkonen only discloses address determination of the agent 130 and registration of the data terminal 126. The above citation of Mikkonen does not disclose or suggest any detecting of when the media peripheral (the data terminal 126) is communicatively coupled to the node (the foreign agent 130), as recited by the Applicant in independent claim 11. Ansell does not overcome the above stated deficiencies of Mikkonen.

Furthermore, with regard to the rejection of independent claim 11 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Mikkonen and Ansell does not disclose or suggest at least the limitation of **“utilizing said acquired security data and security data associated with the node to**

facilitate secure communication between the media peripheral and the communication network,” as recited by the Applicant in independent claim 11 (emphasis added).

The Examiner concedes at page 4 of the Office Action that Mikkonen is silent as to utilizing any security data associated with the media peripheral to facilitate secure communication between the media peripheral, as recited in Applicant’s claim 11. In order to satisfy this deficiency, the examiner looks to Ansell for support.

The Examiner attempts to provide support for security data associated with the media peripheral from Ansell, col. 9 line 58 – col. 10 line 55, which discloses a security key that is stored on a portable music player that allows it access to “secure portable tracks”. Ansell does not disclose or suggest “utilizing said acquired security data and security data associated with the node to facilitate secure communication between the media peripheral and the communication network,” as recited by the Applicant in independent claim 11. In addition, Ansell does not teach facilitating secure communication, but teaches secure storage and playback of data.

Accordingly, Mikkonen in view of Ansell does not render independent claim 11 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant believes that the rejection of the independent claim 11 under 35 USC 103(a), over Mikkonen in view of Ansell has been overcome and respectfully requests that the rejection be withdrawn. The Applicant

respectfully submits that claim 11 is allowable. The Applicant respectfully reserves the right to argue any additional reasons, beyond those set forth above, that support the allowability of claim 11 should that need arise in the future.

B. Rejection of Dependent Claims 12-17

Based on at least the foregoing, the Applicant believes the rejection of independent claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Mikkonen in view of Ansell has been overcome and requests that the rejection be withdrawn. Additionally, claims 12-17 depend from independent claim 11 and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 12-17.

III. Anderson Does Not Render Claims 1-28 Unpatentable

The Applicant now turns to the rejection of claims 1-28 as being unpatentable over Anderson.

A. Independent Claims 1, 11, and 18

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that Anderson does not disclose or suggest at least the limitation of "searching for a previously acquired security data associated with

a location of previous operation of the media peripheral," as recited by the Applicant in independent claim 1.

The Office Action states the following:

Client's certificate validating and communicating with the media peripheral for the offered service reads on "utilizing said acquired security data associated with the media peripheral to facilitate secure communication between the media peripheral and the communication network".

See the Office Action at page 6. With regard to Anderson, the Examiner has provided an extensive summary of the Jini-proxymodel disclosed by Anderson at, for example, pages 41-42. **From the Examiner's summary, as well as from the above citation, it appears that the Examiner equates the "media peripheral" limitation from Applicant's claim 1 with the service module disclosed by Anderson. See e.g., Figure 8.1 of Anderson.** The Examiner further states the following:

Anderson suggests that the client keeps previously read said security data (certificate) that originated from the media peripheral. Caching previously stored security data is old and well known in the art of computing (e.g. a cookie) and as a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to attempt to identify previously acquired security data associated with the media peripheral given the benefit of potential time and bandwidth saving since no data transfer would be required.

See the Office Action at pages 5-6. Initially, regardless of whether the above statement is true or not, the Applicant notes that it appears that claims 1-28 are being rejected based on inherency (See e.g., bolded statement above).

The Applicant submits that a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency.

See Manual of Patent Examining Procedure at § 2112. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *See id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Applicant respectfully submits that neither Anderson itself nor the Office Action “make[s] clear that the missing descriptive matter,” said to be inherent “is necessarily present in” Anderson.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Applicant respectfully submits that the Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, at least claims 1, 11, and 18 of the present application stand rejected based on a conclusory statement of inherency, rather than upon a "basis in fact and/or technical reasoning." Accordingly, the Applicant respectfully submits that, absent a "basis in fact and/or technical reasoning" for the rejection of record, that rejection should be reconsidered and withdrawn.

Even assuming for the sake of argument that Anderson discloses caching of previously read security data for the media peripheral (equated by the Examiner to the service module), the Examiner's argument is still deficient. The Applicant has reviewed Anderson, including the portions cited to by the Examiner, and **Anderson does not disclose or suggest of any security data associated with a location of previous operation of the service module. In fact, there is no disclosure that security information is being processed with regard to a previous location of operation for either the service module, or the client.** Therefore, the Applicant maintains that Anderson does not disclose or suggest at least the limitation of "searching for a previously acquired security data associated with a location of previous operation of the media peripheral," as recited by the Applicant in independent claim 1.

Accordingly, Anderson does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant believes that the rejection of the independent claim 1 under 35 USC 103(a), over Anderson has been overcome and respectfully requests that the rejection be

withdrawn. Independent claims 11 and 18 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 18 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1. The Applicant respectfully submits that claims 1, 11, and 18 are allowable. The Applicant respectfully reserves the right to argue any additional reasons, beyond those set forth above, that support the allowability of claims 1, 11, and 18 should that need arise in the future.

B. Rejection of Dependent Claims 2-10, 12-17, and 19-28

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Anderson has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10 depend from independent claim 1, claims 12-17 depend from independent claim 11 and claims 19-28 depend from independent claim 18, and are, consequently, also respectfully submitted to be allowable at least for the above reasons.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-17 and 19-28.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-28 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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/Ognyan I. Beremski/

Ognyan Beremski, Esq.
Registration No. 51,458
Attorney for Applicant

McANDREWS, HELD & MALLOY, LTD.
500 WEST MADISON STREET, 34TH FLOOR
CHICAGO, ILLINOIS 60661
(312) 775-8000